

REMARKS

This Response is submitted in response to the Office Action dated August 12, 2003. The specification has been amended. Claims 1 to 3, 7, 8, 11, 16, 23 to 29, 38 to 40, 42 to 44, 45 and 52 have been amended. Claim 10 has been canceled without prejudice or disclaimer. No new matter has been added.

A Terminal Disclaimer and a Supplemental Information Disclosure Statement are submitted herewith. A check in the amount of \$290.00 is submitted herewith to cover the cost of the Terminal Disclaimer and the Supplemental Information Disclosure Statement. Please charge deposit account number 02-1818 for any insufficiency of payment or credit any overpayment.

The Office Action rejected Claims 1, 7, 23 and 38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 25, 28, 30 and 47 of U.S. Patent No. 6,506,118. The Office Action rejected Claims 2 and 39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 28, 30 and 47 of U.S. Patent No. 6,506,118. Applicants are hereby submitting a Terminal Disclaimer as indicated in the Office Action and discussed during the interview to overcome these rejections.

The Office Action rejected Claims 1 to 44 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended certain of these claims to overcome these rejections. Accordingly, as discussed during the interview, Applicants respectfully submit that these rejections have been overcome.

The Office Action rejected Claims 1, 2, 5, 7 to 10, 12, 13, 23 to 26, 29 to 32 and 38 under 35 U.S.C. §102(b) as being anticipated by S-Plus Limited: Take Your Pick ("TYP"). Applicants have amended certain of these claims to overcome these rejections by clarifying that at least one of the potential second offers is based on the total value of all previous offers.

The Office Action states that TYP discloses a gaming device that presents the player with a first potential offer (result of the first bonus presented) and if the player chooses to reject that offer, a second offer is determined based on part by the first offer

in that the player can, as part of their rejection of the first offer, hold part of the first offer for application to the second offer. The Office Action also states that the second offer is based upon the first offer in that it still holds in common a mathematical variable for computation of the final offer. The Office Action further states that TYP includes means for the player to reject or accept the first offer.

Amended independent Claim 1 is directed to a gaming device including a processor and a first set of potential offers, wherein one of the potential offers of the first set is adapted to be made to a player by the processor. The gaming device also includes a second set of potential offers wherein at least one potential offer of the second set being determined by the processor if the player rejects the first offer and the potential offer of the second set is based on a total value of all previous offers made to the player, a display device controlled by the processor for displaying the sets to the player and means controlled by the processor for enabling the player to accept or reject the first offer.

Unlike TYP, wherein a subsequent or second offer is based in part on a component of the most recent previous rejected offer (i.e., the part of the first offer held over for application to the second offer), in the gaming device of amended independent Claim 1, at least one potential offer of the second set of potential offers is based on a total value of all previous offers made to the player. That is, while a subsequent offer of TYP is based on a component of the last rejected offer, a subsequent offer of amended independent Claim 1 is based on the total value of all previously rejected offers. As discussed during the interview, TYP does not disclose, teach or suggest the second offer being based on the total value of all previous offers. Accordingly, Applicants respectfully submit that independent Claim 1 is patentably distinguished over TYP and in condition for allowance.

Claims 2 and 5 depend directly or indirectly from independent Claim 1 and are also allowable for the reasons given with respect to independent amended Claim 1 and because of the additional features recited in these claims.

Amended independent Claim 7 is directed to a gaming device including a processor, a plurality of first potential offers, a first offer provided to a player by the

processor from the plurality of first potential offers and at least one second potential offer based on a total value of all previous offers, wherein when the player rejects the first offer, the processor replaces at least one first potential offer with the second potential offer. The gaming device also includes a display device that communicates with the processor and displays the first and second potential offers and an offer acceptor in communication with the processor and enables the player to accept the first offer. As discussed during the interview and as described above with respect to amended independent Claim 1, unlike TYP, at least one of the second potential offers of the gaming device of amended independent Claim 7 is based on a total value of all previous offers. For these reasons, it is respectfully submitted that amended independent Claim 7 is patentably distinguished over TYP and in condition for allowance.

Claims 8, 9, 12 and 13 depend directly or indirectly from Claim 7 and are also allowable for the reasons given with respect to Claim 7, and because of the additional features recited in these claims.

Amended independent Claim 23 is directed to a gaming device including a plurality of values, means for offering one of the values to a player and means for enabling the player to accept one of the values offered to the player. The gaming device also includes means for changing at least one of the values based on each of the previously offered values, if the player does not accept the offered value, wherein at least one of the changed values and another one of the plurality of values is subsequently offered to the player if the player does not accept the offered value. As discussed during the interview, unlike TYP, the gaming device of amended independent Claim 23 includes means for changing at least one of the values based on each of the previously offered values, if the player does not accept the offered value. For this reason, it is respectfully submitted that amended independent Claim 23 is patentably distinguished over TYP and in condition for allowance.

Claims 24 to 26 depend directly or indirectly from Claim 23 and are also allowable for the reasons given with respect to Claim 23, and because of the additional features recited in these claims.

Amended independent Claim 29 is directed to a gaming device including a processor, a display device operable by the processor and a path displayed on the display device, the path including a plurality of positions, wherein a plurality of the positions are each associated with an offer. The gaming device also includes means connected to the processor for generating at least one of the positions of the path, at least one of the offers provided to a player by the processor, wherein the provided offer is associated with one of the generated positions and means connected to the processor for enabling the player to accept or reject the offer, wherein upon a rejection of the offer, at least one offer associated with at least one position is modified based on the total value of all previous offers made to the player. As discussed during the interview, unlike TYP, the gaming device of amended independent Claim 29 includes means connected to the processor for enabling the player to accept or reject the offer, wherein upon a rejection of the offer, at least one offer associated with at least one position is modified based on the total value of all previous offers made to the player.

Moreover, the Office Action states that in TYP, the presentation of the offers is that of the form of a path with a plurality of positions. However, unlike the path of TYP, in the gaming device of amended independent Claim 29, a plurality of the positions of the path are each associated with an offer. That is, while the positions of the path of TYP are associated with a plurality of offer components, a plurality of the positions of the path of the gaming device of amended independent Claim 29 are each associated with an offer. For these reasons, it is respectfully submitted that amended independent Claim 29 is patentably distinguished over TYP and in condition for allowance.

Claims 30 to 32 depend directly or indirectly from Claim 29 and are also allowable for the reasons given with respect to Claim 29, and because of the additional features recited in these claims.

Amended independent Claim 38 is directed to a gaming device including a processor, a display device that communicates with the processor and a plurality of potential offers displayed by the display device. The gaming device also includes an offer provided to a player by the processor from the potential offers, the offer based on a total value of each offer previously provided to the player and means which

communicates with the processor for enabling the player to accept the provided offer. As discussed during the interview and as described above with respect to amended independent Claim 1, unlike TYP, the offer provided to the player of the gaming device of amended independent Claim 38 is based on a total value of each offer previously provided to the player. For these reasons, it is respectfully submitted that amended independent Claim 38 is patentably distinguished over TYP and in condition for allowance.

The Office Action rejected Claims 1, 7, 23 and 38 under 35 U.S.C. §102(b) as being anticipated by Hooker. Applicants respectfully disagree with these rejections because Hooker fails to disclose each and every element of the presently claimed invention. Specifically, Hooker fails to disclose enabling the player to accept or reject the first offer.

Hooker relates to a gaming device with a plurality of wheels or drums that each bear a variety of symbols. The wheels are spun and if a winning combination of symbols are displayed on the spun wheels, the player is provided an award or prize. Moreover, the gaming device permits the player to select a specific symbol at which the wheel will stop.

The Office Action states that the player is offered the prize associated with the result of the first spin of the wheels and if the player chooses not to accept that prize, the play can hold a number of the symbols in order to then be offered with a second offer that is based in part on the first offer due to the symbol that is held over. Applicants respectfully disagree with this interpretation of Hooker and submit that, unlike the gaming device of amended independent Claims 1, 7, 23 and 38, the gaming device disclosed in Hooker is not an offer and acceptance game. That is, the result of the first spin of the wheel in Hooker is not an offer to be accepted or rejected, but the reward or prize associated with the resulting symbol combination. In other words, the first spin of the wheels is the play of the first play cycle and the second spin of the wheels is the play of the second play cycle. On the other hand, as described above and discussed during the interview, unlike Hooker, in the gaming device of amended independent Claims 1, 7, 23 and 38, the player is enabled to accept or reject the offer. For these

reasons, it is respectfully submitted that amended independent Claims 1, 7, 23 and 38 are patentably distinguished over Hooker and in condition for allowance.

The Office Action rejected Claims 3, 11, 27, 28, 34 and 39 to 53 under 35 U.S.C. §103(a) as being unpatentable over TYP. Applicants respectfully disagree with these rejections because as described above and discussed during the interview, TYP does not teach, disclose or suggest basing the second offer on the total value of all previous offers.

The Office Action states that regarding Claims 3, 11, 39, 40 and 52, TYP discloses that the second offer is mathematically related to the first offer as a multiplicative relation. The Office Action concludes that the inclusion of the second set of offers being additive relations as opposed to multiplicative relations (Claims 3, 11, 39 and 52) and that the offer includes a multiplication of the value to a previously displayed potential offer (Claim 40) would be been obvious to one of ordinary skill in the art based upon the disclosure of TYP. Applicants respectfully disagree with this conclusion, but nonetheless have amended certain of these claims to clarify that that the second offer is based on the total value of all previous offers made to the player. Applicants respectfully submit that as discussed during the interview, unlike in Claims 3, 11, 39, 40 and 52, TYP does not teach, disclose or suggest basing the second offer on the total value of all previous offers. For these reasons, it is respectfully submitted that amended independent Claims 3, 11, 39, 40 and 52 are patentably distinguished over TYP and in condition for allowance.

The Office Action states that regarding Claims 27, 28 and 34, it would have been within the skill of one of ordinary skill in the art to allow the device to change the value based on increasing the values not previously offered or chosen. The Office Action concludes that the manner in which the values are changed, determined and presented is a design choice and it would have been obvious to one of ordinary skill in the art to adapt the values in view of the disclosure of TYP. Applicants respectfully disagree with this conclusion, but nonetheless have amended certain of these claims to clarify that the value changing means includes means for increasing at least one of the values not offered to the player based on each of the previously offered values. Applicants

respectfully submit that as discussed during the interview, unlike in Claims 27, 28 and 34, TYP does not teach, disclose or suggest means for increasing at least one of/each the values not offered to the player based on each of the previous offers as in Claims 27, 28 and 34. For these reasons, it is respectfully submitted that amended independent Claims 27, 28 and 34 are patentably distinguished over TYP and in condition for allowance.

Amended independent Claim 45 is directed to a method for operating a gaming device including the steps of: (a) displaying a plurality of potential offers, (b) generating and providing a first offer from the potential offers to a player, (c) changing the value of at least one of the remaining potential offers based on a total value of each of the previously provided offers, (d) enabling a player to accept or reject the provided offer and (e) generating one of the newly changed potential offers and providing the newly changed potential offer as a second offer to the player if the player rejects the first offer and if the second offer has not been previously generated. As discussed during the interview, TYP does not teach, disclose or suggest changing the value of at least one of the remaining potential offers based on a total value of each of the previously provided offers. For these reasons, it is respectfully submitted that amended independent Claim 45 is patentably distinguished over TYP and in condition for allowance.

Claims 46 to 53 depend directly or indirectly from Claim 45 and are also allowable for the reasons given with respect to Claim 45, and because of the additional features recited in these claims.

Regarding Claims 36, 37, 41 to 44 and 46 to 47, the Office Action states that it is known in the art to offer a consolation prize to players in a bonus environment to assure a prize is won. The Office Action concludes that the means in which the consolation prize is awarded, calculated, supplemented or shown would be easily conceived, altered and designed by one of ordinary skill in the art and thus would be obvious design choices to a skilled artisan in relation to incorporating a terminator and compensating a player for the bonus. Applicants respectfully disagree with these conclusions. Nonetheless, assuming arguendo that it would have been obvious to include a consolation prize in TYP, Applicants respectfully submit that TYP does not

teach, disclose or suggest associating each of a plurality of positions of a path with an offer (Claims 36 and 37), providing an offer to a player wherein the offer is based on a total value of each offer previously provided to the player (Claims 41 to 44) or changing the value of at least one of the remaining potential offers based on a total value of each of the previously provided offers (Claims 46 and 47). For these reasons, it is respectfully submitted that Claims 36,37, 41 to 44 and 46 to 47 are patentably distinguished over TYP and in condition for allowance.

The Office Action rejected Claims 4, 6, 14 to 22, 33 and 35 to 37 under 35 U.S.C. §103(a) as being unpatentable over TYP in view of Baerlocher et al. Applicants respectfully submit that Baerlocher et al. (U.S. Patent No. 6,506,118) is commonly owned by the assignee of the present patent application. A copy of the Assignment is attached herewith. Accordingly, under §706.02(l)(3) of the MPEP, such commonly owned reference is disqualified as prior art under 35 U.S.C. §103. Therefore, as described above with respect to Claims 1 and 7, TYP does not teach, disclose or suggest that the second potential offer is based on a total value of all previous offers as disclosed in Claims 4, 6, 14 and 15. Moreover, as discussed about with respect to Claim 29, TYP does not teach, disclose or suggest a plurality of positions of a path that are each associated with an offer as disclosed in Claims 35 to 37. Accordingly, Applicants respectfully submit that Claims 4, 6, 14, 15, 33 and 35 to 37 are patentably distinguished over TYP and in condition for allowance.

Amended independent Claim 16 is directed to a gaming device including a processor, a plurality of potential offers, a display device controlled by the processor that displays the potential offers and a first offer provided to a player by the processor from the plurality of potential offers. The gaming device also includes a second offer equal to a sum of each of the previous offers plus one of the potential offers, the second offer provided to the player by the processor upon a rejection of the first offer and a potential terminator displayed by the display device upon the rejection of the first offer. As discussed during the interview, unlike the gaming device of amended independent Claim 16, TYP does not teach, disclose or suggest a second offer equal to each of the previous offers plus one of the potential offers. For these reasons, Applicants

respectfully submit that Claims 16 to 22 are patentably distinguished over TYP and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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BY



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